

The specification is amended hereby in conformance with 37 C.F.R. 1.78(a)(2) to contain a Cross-Reference to the Related Application in the first sentence following the title. The prior Cross-Reference has been deleted hereby from the substitute specification.

In the above amendments, claims 1-47 have been cancelled and new claims 48-126 have been added. Pursuant to 37 C.F.R. §1.73, which states that "Such summary should, when set forth, be commensurate with the invention as claimed...", the original "Summary of the Invention" section of the specification has been replaced with a new summary in order to make the summary more consistent with the current claims.

The cancellation of claims 1-47 should not be considered an admission that the subject matter of any of those claims is unpatentable, and those claims have been cancelled without prejudice to include them or similar claims into one or more divisional or continuation applications.

In view of above amendments and the following remarks, reconsideration of the application is respectfully requested.

New claim 48 corresponds to original claim 1 amended to more clearly recite that a ticket is dispensed by a first output device after the occurrence of a triggering event, wherein the triggering event is not the occurrence of a predetermined outcome wherein the player is provided with a gaming award. New claim 48 further more clearly recites that the triggering event is not every occurrence of the wagering game. New dependent claims 49-83 correspond to original claims 2-36 amended for consistency with new claim 48. New claim 65 corresponds to original claim 18 further amended to more clearly recite that the secondary game unit comprises a secondary display device adapted to display a randomly selected portion of secondary indicia corresponding to an outcome of a secondary event occurring at the gaming device. New claim 66 corresponds to original claim 19 further amended for consistency with new claim 65. The revisions to claims 65 and 66 are supported in the substitute specification filed with the January 15, 2002 Preliminary Amendment at least at FIG. 2 and the accompanying text at page 5, numbered paragraph 0023 wherein the gaming device 200 is illustrated as having a secondary event in the form of a video display of a rotatable reel 250. Consequently, no new matter is added by the addition of new claims 48-83.

New claims 84-115 are directed to a method of conducting a wagering game wherein a ticket is dispensed to a player after the occurrence of a triggering event, wherein the triggering event is not the occurrence of a predetermined outcome wherein the player is provided with a gaming award, and is not every occurrence of the wagering game. Support for method claims 84-115 is provided in the specification. For example, the subject matter of claims 84-115 are at least supported by original claims 1, 4, 6-12, 12-18, 20-31 and 33-36, respectively. Therefore, applicants respectfully submit that no new matter is added by the addition of new claims 84-115.

New claim 116 corresponds to original claim 37 amended to more clearly recite that the method of conducting a wagering game includes accumulating comp points for a player as the player plays the wagering game, displaying a visible indication of the accumulated comp points to at the gaming device, and providing the player with the opportunity to redeem at least a portion of the accumulated comp points at the gaming device. New dependent claims 117-126 correspond to original claims 38-47 amended for consistency with new claim 116. Consequently, no new matter is added by the addition of new claims 116-126.

Original claims 18 and 19 were rejected under 35 U.S.C. §112, second paragraph as being incomplete for omitting essential elements. Applicants respectfully submit that new claims 65 and 66 would not be properly rejected under the provisions of §112. Reconsideration is respectfully requested. New claims 65 and 66 correspond to original claims 18 and 19 as discussed above. New claim 65 more clearly recites that randomly selected portion of secondary indicia displayed at the secondary display device of the secondary game unit of the gaming device correspond to an outcome of a secondary event occurring at the gaming device. Applicant believe that new claim 65 recites the essential matter necessary to enable the invention claimed therein, and it interrelates the essential elements and, therefore, points out and distinctly claims the invention. Applicants respectfully submit that new claim 65 and new claim 66 depending therefrom are in condition for allowance.

Claims 1-11 and 31 were rejected under 35 U.S.C. §102(b) as being anticipated by Clapper Jr. (U.S. Patent. No. 5,609,337, hereinafter "Clapper Jr. '337"), claims 12 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clapper Jr. '337 in view of Boushy (U.S. Patent No. 5,761,647), claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Clapper Jr. '337 in view of Clapper Jr. et al. (U.S. Patent No. 5,928,082,

hereinafter "Clapper Jr. '082), claims 14 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clapper Jr. '337 in view of Burns et al. (U.S. Patent No. 6,048,269), claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Clapper Jr. '337 in view of Harrison (U.S. Patent No. 5,934,671), claims 18 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clapper Jr. '337 in view of Baerlocher et al. (U.S. Patent No. 5,788,573), claims 20-27, 30 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clapper Jr. '337 in view of Mullins (U.S. Patent No. 5,158,293) and Burns, claims 28 and 33-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clapper Jr. '337, Mullins and Burns and further in view of Libby et al. (U.S. Patent No. 4,982,337), and claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over Clapper Jr. '337, Mullins and Burns and further in view of Wilder (U.S. Patent No. 5,408,417). Applicants' amendment canceling claims 1-36 and presenting new claims 48-115 renders these rejections moot.

New independent apparatus claim 48 recites that the first output device is adapted to dispense a ticket after the occurrence of a triggering event, and new independent method claim 84 recites the dispensing of a ticket to the player after the occurrence of a triggering event. The triggering event is neither the occurrence of a predetermined outcome of the wagering game wherein the player is provided a gaming award, nor every occurrence of the wagering game. The Clapper Jr. '337 patent, the primary reference applied by the Examiner, discloses a gaming ticket dispenser that dispenses pull-tab tickets containing indicia which may constitute winning or scoring indicia. (Clapper Jr. '337, Abstract). The gaming ticket dispenser includes a display means which displays the indicia on the pull-tab tickets. (Clapper Jr. '337, Abstract). Each dispensed pull-tab ticket constitutes one occurrence of the game of chance. The display means merely displays the indicia on the ticket, and the gaming ticket dispenser is not disclosed as providing any other wagering game. Therefore, Clapper Jr. '337 does not disclose or suggest a triggering event for dispensing a ticket that is not every occurrence of the game of chance and, consequently, Clapper Jr. '337 alone neither anticipates nor renders obvious new independent claims 48 and 84, and claims 49-83 and 85-115, respectively, depending therefrom.

The remaining references applied by the Examiner similarly do not appear to either disclose or suggest a triggering event as recited in claims 48-115. It follows, therefore, in the opinion of the applicants that the applied references neither anticipate nor render obvious

claims 48-115. *See In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985) (the prior art must make a suggestion of or provide an incentive for the claimed combination of elements in order to establish a *prima facie* case of obviousness). Because the applied references do not appear to teach or suggest a triggering event that is neither the occurrence of a predetermined outcome of the wagering game wherein the player is provided a gaming award, nor every occurrence of the wagering game, the applicants respectfully submit that claims 48-115 are now in condition for allowance, and the applicants respectfully request allowance of these claims at the Examiner's earliest convenience.

Claims 37-41 and 44-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boushy, and claims 42 and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boushy in view of Burns et al. Reconsideration is respectfully requested in view of applicants' amendment canceling claims 37-47 and presenting new claims 116-126. New independent claim 116 more clearly recites a method wherein a visible indication of a player's accumulated comp points is displayed at the gaming device, and the player is provided with the opportunity to redeem at least a portion of the accumulated comp points at the gaming device via an input device. Boushy discloses a customer recognition system wherein slot machines 130 includes a card reader to track a customer's betting activity and transfer data to a casino management system 234. (Boushy, col. 5, lines 53-64, col. 9, lines 40-45). Customers check on activity points, comp availability and comp arrangements at non-gaming devices such as kiosks 136, customer information centers 138, and workstations 118 and 148. (Boushy, col. 8, lines 15-21, col. 9, lines 46-50). Boushy does not appear to disclose or suggest that either the slot machines 130 or any other gaming device provides the player with either a display of accumulated comp points or the opportunity to redeem accumulated comp points. Burns et al. does not appear to provide any disclosure or suggestion of displaying or redeeming accumulated comp points, let alone displaying or redeeming comp points at a gaming device. Because the applied references do not appear teach or suggest either displaying a visible indication of a player's accumulated comp points at the gaming device, or providing the player with the opportunity to redeem at least a portion of the accumulated comp points at the gaming device via an input device, the applicants respectfully submit that claims 116-126 are now in condition for allowance, and the

applicants respectfully request allowance of these claims at the Examiner's earliest convenience.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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